

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 6, 2008. At the time of the Final Office Action, Claims 1-6, 8-15 and 17-21 were pending in this Application. Claims 1-6, 8, 13-15 and 17-21 were rejected. Claims 9-12 were previously withdrawn due to an election/restriction requirement and Claims 7 and 16 were previously cancelled without prejudice. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 14, 15 and 17 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,794,800 issued to Rudolf Heinz (“*Heinz*”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner maintained his rejection of independent claim 14 as being unpatentable over *Heinz*. In the section “Response to arguments”, the Examiner stated that *Heinz* discloses profiled sheets with contacting surfaces that extend in both directions from the comb back (item 10), which results in first and second contacting surfaces formed along first and second contact tracks. Applicant agrees to the Examiner’s analysis of *Heinz*. In fact, *Heinz* discloses a comb back 10 from which fingers extend in both directions, i.e the left and right, as shown in Figs. 1-8. However, Applicants are claiming a different structure.

Independent claim 14 clearly states that one side of the profiled sheet has first and second contact surfaces spaced at intervals from one another. *Heinz*, on the contrary, doe

have only a single set of surfaces on one side which only form a single track. The second track, as correctly analyzed by the Examiner, is formed on the other side of the comb body. Even though the arrangement of *Heinz* results in a profiled sheet with two tracks, namely the track on the left side and the track on the right side, the profiled sheet does not provide for two tracks that are located on a single side. Hence, independent claim 14 and dependent claims 15 and 17 cannot be anticipated by *Heinz*.

Rejections under 35 U.S.C. §103

Claims 1-6, 8, 13 and 18-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Heinz* in view of U.S. Patent No. 7,259,504 issued to Willibald Schürz et al. (“*Schürz*”) and U.S. Patent No. 6,316,863 issued to Carsten Schuh et al. (“*Schuh*”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Examiner maintained his former rejection of claim 1. Independent claim 1 includes the limitation “*the profiled sheets are fixed to an external surface of a plastic cage and the piezoceramic is positioned in a cavity of the plastic cage.*” In the section Response to Arguments, the Examiner stated that *Schürz* allegedly discloses that the profiled sheets are fixed to an external surface of a cage material (Fig. 3). Applicant respectfully disagrees. Fig. 3 of *Schürz* does not disclose any type of cage material. Applicant respectfully requests the Examiner to explain which material shown in Fig. 3 is considered as a cage material. Layer 14 shown in Fig. 3 is an adhesive layer used to glue the profiled sheet to the piezoelectric actuator. *Schürz*, col. 3, lines 58-60. *Schürz* neither discloses nor states that the adhesive material is part of a plastic cage, let alone an external surface of a plastic cage. Even if a person skilled in the art would consider the adhesive 22 as a plastic cage, which Applicant strongly disagrees with, the profiled sheets would at best be fixed to an internal surface. *Schürz* clearly states that piezoelectric actuator 1 with the glued-on outer electrodes is covered in a continuous layer of adhesive 22. *Schürz*, col. 4, lines 40-43. If the layer over the piezoelectric actuator is continuous, such an encapsulation cannot have external surfaces to which profiled sheets are fixed.

Applicants further maintain their reasoning as presented in the last response that *Schürz* does not disclose a plastic cage. Fig. 2 of *Schürz* shows that the electrodes are directly soldered by means of their ends 12 to a metallization strip 5 on the piezoceramic. See, *Schürz* col. 3, lines 37-41. Only the end points 12 of the electrodes are soldered to the strip 5. The rest of the electrode is covered with an adhesive 14 as shown in Fig. 3 and Fig. 4. *Schürz* col. 3, lines 58-60. An adhesive can however not be considered a plastic cage having a cavity. The Examiner failed to explain why a person skilled in the art would consider a continuous covering with an adhesive as a plastic cage.

Even if the combination of adhesive 14 and 20 is considered to form a cage as alleged by the Examiner, then this cage would have external surfaces on the outside which clearly are in no contact with the profiled sheets and other surfaces directed inwards that would be in touch with the piezoceramic element. The whole combination would further enclose the profiled sheets. However, none of the external surfaces would be in contact with the profiled sheet. Hence, Applicant believes that *Schürz* does not disclose the limitation that the profiled

sheets are fixed to an external surface of a plastic cage and the piezoceramic is positioned in a cavity of the plastic cage as claimed in independent claim 1.

Applicants respectfully submit that the remaining dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102 or §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized, cursive script.

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Date: October 6, 2008

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